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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,303	10/16/2001	Richard M. Bentley	110878	4673

27074 7590 05/06/2005

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EXAMINER
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JEAN GILLES, JUDE

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/977,303	<b>Applicant(s)</b> BENTLEY, RICHARD M.	
	<b>Examiner</b> Jude J. Jean-Gilles	<b>Art Unit</b> 2143	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

This Action is in regards to the Reply received on 09 March, 2005.

#### ***Response to Amendment***

1. This action is responsive to the application filed on March 9<sup>th</sup>, 2005. By this amendment, claims 1 and 11 have been amended. No new claims have been added. Therefore, claims 1-20 are currently pending, and represent a method and an apparatus for "generating a user interest profile through monitoring and filtering of electronic messages".

2. Applicant's arguments with respect to claims 1 and 11 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new ground of rejection as explained here below, necessitated by Applicant substantial amendment (*i.e.*, "*a method and an apparatus wherein, for each selected message, the selected message is selected and the extracted profile data is extracted before the user reads the selected message.*") to the claims which significantly affected the scope thereof.

Applicant mentions in page 6, lines 16 the phrase "Applicant amends claims 1 and 11" whereas independent claims 1 and 12 have instead been amended. Examiner assumes that this was a typo and examined the amended claims 1 and 12.

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The dependent claims stand rejected as articulated in the First Office Action and all objections and/or rejections not addressed in Applicant's response are herein reiterated.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3, 5, 6, 8, 8, 11-12, 14-15, 17, and 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hertz (Hertz), U.S. Patent No. 6,029,195, in view of Davies et al. (Davies), U.S. Patent No. 6,353,827.

Regarding **claim 1**, Hertz discloses the invention substantially as claimed. Hertz teaches a method for generating or extending a user interest profile (fig. 10, items 1101-1108), comprising:

monitoring electronic messages directed to the user (*column 18, lines 25-49*);

selecting those electronic messages satisfying at least one predetermined condition indicating that they are likely to include information relevant to the user's interests (*column 18, lines 1-67; column 19, lines 1-5*); and

extracting profile data from the selected messages (*column 19, lines 5-7*);

however, Hertz does not specifically teach a method wherein, for each selected

message, the selected message is selected and the extracted profile data is extracted before the user reads the selected message.

In the same field of endeavor, Davies discloses a method that contains an “*agent that is installed on a user’s machine, the user provides a personal profile: a set of keywords which describe information the user is interested in obtaining via W3. This profile is held, or at least maintained, by the agent in order to determine which pages are potentially of interest to the user ...*” [see Davies, figs. 4, 6, 7, and 8; column 6, lines 52-67].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Davies’ teachings of a method and apparatus to use an agent to extract profile data before the user reads the pages, with the teachings of Hertz, for the purpose of “*...allowing the user to access information by a much richer set of meta-information...*” as stated by Davies in lines 29-32 of column 4. Thus, Hertz also provides motivation to combine by stating a need to also provide to the network with “*an information retrieval and delivery system operable in an electronic media environment that enables the user to access information of relevance and interest to the user without requiring the user to expend an excessive amount of time and energy ...*” [see Hertz, column 4, lines 28-33]. By this rationale **claim 1** is rejected.

Regarding **claim 12**, the combination Hertz-Davies teaches an apparatus for generating or extending a user interest profile [see Hertz, fig. 10, items 1101-1108], the method comprising:

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means for monitoring electronic messages directed to the user [see *Hertz*, column 18, lines 25-49];

means for selecting those electronic messages satisfying at least one predetermined condition indicating that they are likely to include information relevant to the user's interests [see *Hertz*, column 18, lines 1-67; column 19, lines 1-5]; and

means for extracting profile data from the selected messages [see *Hertz*, column 19, lines 5-7].

wherein, for each selected message, the selected message is selected and the extracted profile data is extracted before the user reads the selected message [see *Davies*, figs. 4, 6, 7, and 8; column 6, lines 52-67]. The same motivation that was used for claim 1 is also valid for claim 12 [see *Hertz*, column 4, lines 28-33; see *Davies*, column 4, lines 29-32]. By this rationale, **claim 12** is rejected.

**Dependent Claims 2-3, 5, 6, 8, 8, 11, 14-15, 17, and 19-20** stand rejected as articulated in the First Office Action and are herein reiterated in view of the rationale of the independent **claim 1 and 12** as explained above.

5. **Claims 4, 7, 9-10, 13, 16, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hertz* and *Davies* as stated in claims 1 and 12 above, and further in view of *Gershman* U.S. Patent No. 6,029,195.

**Dependent Claims 4, 7, 9-10, 13, 16, and 18** stand rejected as articulated in the First Office Action and are herein reiterated in view of the rationale of the independent **claims 1 and 12** as explained above.

### ***Response to Arguments***

6. Applicant's Request for Reconsideration filed on March 9<sup>th</sup>, 2005 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main point of contention:

Independent Claims 1 and 12 have been amended, and in the currently amended state, the Hertz patent fails to clearly anticipate a method and apparatus wherein, for each selected message, the selected message is selected and the extracted profile data is extracted before the user reads the selected message.

6. It is the position of the Examiner that Hertz does not teach in detail the above limitation in the claim. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained above. The Davies patent discloses a method and an apparatus that contain an "*agent that is installed on a user's machine, the user provides a personal profile: a set of keywords which describe information the user is interested in obtaining via W3. This profile is held, or at least maintained, by the agent in order to determine which pages are potentially of interest to the user ...*" [see Davies, *figs. 4, 6, 7, and 8; column 6, lines 52-67*]. In combination with Hertz and Gershman, the hertz patent makes the current invention obvious and claims 1-20 have been rejected under **35 U.S.C. 103(a)**.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this action.

8. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3719.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

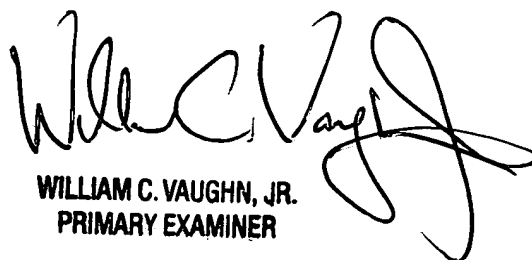
Jude Jean-Gilles

Patent Examiner

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JJG

April 20, 2005



WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER